



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,516	12/30/1998	DENNIS M. O'CONNOR	INTL-0134-US	1486

21906 7590 01/11/2006

TROP PRUNER & HU, PC
8554 KATY FREEWAY
SUITE 100
HOUSTON, TX 77024

EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
----------	--------------

2616

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/223,516	Applicant(s) O'CONNOR ET AL.	
	Examiner HUY T. NGUYEN	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 October 2005 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 45, 47 and 48 is rejected under 35 U.S.C. 102(b) as being anticipated by Hibi et al (5,546,191).

Regarding claim 45, Hibi discloses a receiver (Fig. 19) comprising:

Art Unit: 2616

a first device (tuner) to receive a broadcast television program;

a second device (97) coupled to said first device to detect a characteristic of said program (column 28, lines 1-20); and

third device (recorder) to record a portion of said program in response to the detection of said characteristic (column 28, lines 1-200).

Regarding claim 47, Hibi further teaches said receiver is a computer system since the receiver having capacity of detect comparing, controlling and gathering portions of program and program (Fig. 16). (column 5, lines 15-21).

Regarding claim 48, Hibi further teaches means for concatenating a series of recorded replays (Fig. 16).

4. Claims 45-46 and 48-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamamura (5,784,522).

Regarding claim 45, Yamamura discloses a receiver (Fig. 6, column 7, lines 1-35) comprising:

a first device (31) to receive a broadcast television program (column 1, lines 2-30);

a second device (34) coupled to said first device to detect a characteristic of said program (start and stop signals); and

third device (33) to record a portion of said program in response to the detection of said characteristic.

Regarding claim 46, Yamamura further teaches the second device to detect a queue encoded with the program (column 8, column 10).

Regarding claim 47, Yamamura further teaches said receiver is a computer system since the receiver having capacity of receiving , detecting , comparing , recording and transmitting the received portion of the program .

Regarding claim 49, Yamamura further teaches said second device to detect a signal indicating that recording should start and another signal indicating that recording should end (recording Start/Stop signals)(Fig. 6).

Regarding claim 50, Yamamura further teaches said first device to receive a signal including a queue to indicate the start of recording by said video recorder (Fig. 6).

5. Claims 45-46 and 48-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Heo et al (DE 19737889) ,(US 2002/0176689 A1 is a family member of (DE 19737889 and is used as English translation).

Regarding claim 45, Heo discloses a receiver (US 2002/0176689 A1 (Fig. 2) , page 1 section 0021, page 2 , sections 0023 –0035) comprising:

- a first device (ANT and tuner) to receive a broadcast television program;
- a second device (206) coupled to said first device to detect a characteristic of said program (highlight portion); and
- third device (recorder) to record a portion of said program in response to the detection of said characteristic.

Regarding claim 46, Heo further teaches the second device to detect a queue encoded with the program (US 2002/0176689 A1, Fig. 4).

Regarding claim 49, Heo further teaches said second device to detect a signal indicating that recording should start and another signal indicating that recording should end (US 2002/0176689 A1, Fig. 6 and 8).

Regarding claim 50, Heo further teaches said first device to receive a signal including a queue to indicate the start of recording by said video recorder (US 2002/0176689 A1, Fig. 4).

Applicant argues that the parent application discloses three elements recited in claim 45 of the present application. Examiner disagrees. It is noted that the parent application does not disclose the elements for detecting the characteristic in the received broadcast program and for recording a portion of the program based in the detected characteristic that are being recited in claim 45 of the present application.

6. Claims 45-46 and 48-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Nielsen et al (5,778,137).

Regarding claim 45, Nielsen discloses a receiver comprising a first device for receiving a broadcast program; a second device (109) coupled to said first device to detect a characteristic of said program (highlight portion) (reference level) and

a video recorder (113) to record as a replay a portion of said program in response to the detection of said characteristic (column 1, lines 50-65, column 2, lines 30-36, column 3, lines 1-41, column 4, lines 5-20).

Regarding claim 46, Nielsen further teaches the second device to detect a queue encoded with the program (column 3, lines 5-20).

Regarding claim 47, Nielsen further teaches said receiver is a computer system. (column 5, lines 15-21).

Regarding claim 49, Nielsen further teaches said second device to detect a signal indicating that recording should start and another signal indicating that recording should end (Column 3, lines 8-20, column 4, lines 40-50) ..

Regarding claim 50, Nielsen further teaches said first device to receive a signal including a queue to indicate the start of recording by said video recorder (column 3 lines 8-20, column 4, line 40-50)).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 2616

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen in view of Ottesen et al (5,721,878).

Regarding claim 48, Nielsen further teaches that the receiver can record a plurality of relays (column 2, lines 1-10) but fails to teach means for concatenating .

Ottesen teaches said receiver to automatically concatenate a series of recorded replays (column 14, lines 25-35, Figs. 8 and 9) .

It would have been obvious to one of ordinary skill in the art to modify Nielsen with Ottesen by provide the receiver of Nielsen with a concatenating means as taught by Ottesen for enhancing the capacity of the apparatus of Nielsen in concatenating the recorded relay.

9. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over al Heo (DE 19737889) , (US 2002/0176689 A1 is a family member of (DE 19737889) and is used as English translation in view of Lee et al (6,310,839).

Regarding claim 48, Heo fails to teach means for concatenating the recorded replay.

Lee teaches a receiver to automatically concatenate a series of recorded replays (Fig. 7).

Art Unit: 2616

It would have been obvious to one of ordinary skill in the art to modify Heo with Lee by provide the receiver of with a concatenating means as taught by Lee for enhancing the capacity of the apparatus of Heo in concatenating the recoded relay.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N


HUY T. NGUYEN
PRIMARY EXAMINER